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| 09/478,051 | 01/15/2000 | MICHAEL J. PICCIALLO | P-22425-B-US | 1136 |

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EXAMINER

HEWITT II, CALVIN L

| | |
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| ART UNIT | PAPER NUMBER |
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3621

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/478,051

Applicant(s)

PICCIALLO, MICHAEL J.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 75-85,87-96,98-108 and 110 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 75-85,87-96,98-108 and 110 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7-1-05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Status of Claims

1. Claims 75-85, 87-96, 98-108 and 110 have been examined.

Examiner's comments

2. "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation" (MPEP, 2106, II, C). The Examiner regards the language of "may be" or "accessible" as language that does not require steps to be performed. Similarly, intended use language (e.g. "for use by..."-claim 75, "is established for..."- claim 77) also does not further limit Applicant's claimed method. It has also been held that in order for structure to be given weight in a method claim the claimed structure must affect the method in a manipulative sense (*Ex parte Pfeiffer*, 135 USPQ 31 (BdPatApp&Int 1961)). Therefore, language that describes the structure of a network "wherein said fund depositor account and said third party account are both in communication with an external bank..." (e.g. claim 76) does not further limit Applicant's claimed method.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 75-85, 87-96, 98-108 and 110 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 75 recites "supplying to said fund depositor through a CRT or LCD output device *said information*" (emphasis added). However, claim 75 recites "using information" and "storing information", therefore it is unclear to one of ordinary skill which "information" Applicant is referring to (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)). Claims 84, 99, 106 and 108 recite similar language.

Claims 76-84, 87, 100-105, 107 and 110 are also rejected as each depends from either claim 75 or 99.

Claim 75 recites the limitation "the periodic and automatic transfer" in line 7. Claims 88 and 99 recite similar language.

Claims 76-84, 87, 89-96, 98, 100-105, 107 and 110 are also rejected as each depends from claim 75, 88 or 99.

Claim 78 recites the limitation "each transfer requested" in line 4. Claims 80, 88 and 99 recite the limitation "the request" in lines 3 and 5, respectively. There is insufficient antecedent basis for this limitation in the claim.

Claims 79, 87, 89-96, 98, 100-108 and 110 are also rejected as each depends from claim 78, 88 or 99.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 75-85, 87-96, 98-108 and 110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakano et al., U.S. Patent No. 5,845,260 in view of Anderson et al., U.S. Patent No. 5,706,442.

As per claims 75-85, 87-96, 98-108 and 110, Nakano et al. teach a computer based method for transferring funds to a third party comprising:

- using information entered by a depositor on a PC to create a third party account (figures 2 and 6)
- periodic (e.g. weekly, monthly) and automatic transfer of funds into the third party account (column 6, lines 47-57)
- [periodically] limiting the funds spent and how funds are spent (abstract; column 6, lines 47-57; column 7, lines 15-25 and 43-50; column 8, lines 4-9)

As per claims 78, 80, 88 and 99, it is inherent that a bank or other financial institution will verify that there are sufficient funds in an account in order support a funds transfer, for example. Nakano et al. disclose storing information on fund transferees and payment amounts for said third party account (figures 2 and 6; column 4, lines 42-53; column 6, lines 11-28) however, Nakano et al. do explicitly recite a depositor viewing said information. Anderson et al. teach presenting account activity and balances to a user at CRT or LCD device (column/line 1/55-2/8) over the internet (column/line 1/55-2/8). As per claims 84 and 108, a well known method for exchanging data over the internet is via electronic mail. Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Nakano et al. and Anderson et al. in order to enable depositors to efficiently keep track her/his finances ('442, column/line 1/22-2/7).

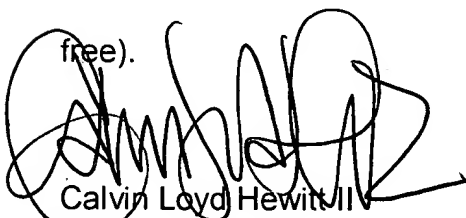
Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:
 - Daly et al. teach a method and system for controlling the purchases of family members, for example, at a POS, PC or set-top box

7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Calvin Loyd Hewitt II
Primary Examiner

November 6, 2006